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REMARKS**I. Introduction**

Claims 1-30 are pending in the above application.

Claims 1-30 stand rejected under 35 U.S.C. § 102.

Claims 1, 2 and 21 are independent claims.

II. Rejections Under Prior Art

Claims 1-30 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Capek et al. (U.S. Pat. 6,094,677).

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, Akzo N.Y. v. U.S. Int'l Trade Commission, 808 F.2d 1471 (Fed. Cir. 1986); Connell v. Sears, Roebuck & Co., 220 USPQ 193, 198 (Fed. Cir. 1983).

As explained in Applicant's prior responses filed on July 5, 2005 and November 18, 2005, both of which are herein incorporated, Capek does not disclose or suggest inserting an alternative media file into a streaming multimedia file using a first and second cache, a control unit, and a switching mechanism, wherein the alternative media file is inserted in the stream independent of boundaries of the multimedia file, as substantially recited by amended claims 1 and 21. Capek discloses to provide an insert during a delay of receiving requested data. Abs.; Figs. 4A and 4B. Capek discloses to maintain an insertion repository 22 which provides inserts to insertion manager 20, at which point insertions are made in a delay period. Fig. 2. Capek discloses to determine if an insert should be provided based on the sufficiency of the delay period, which may

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be determined by the actual delay seen or an expected delay based on historical information. Col. 10: 52-68; and col. 11: 61 – col. 12: 24. Once the data is retrieved it is provided after the insert, i.e. when the insert is selectively provided with the data, the insert is provided at the beginning of the data – during the delay in retrieving the data. Figs. 3-7; col. 10: 29-51; col. 12: 47-55. Capek does not disclose or suggest inserting an alternative media file into a streaming multimedia file using a first and second cache, a control unit, and a switching mechanism, wherein the alternative media file is inserted in the stream independent of boundaries of the multimedia file.

While Applicant respectfully appreciates the discussion of Capek in the Office action, Applicant respectfully disagrees with the conclusions reached in the Office action. Particularly, the Office action responds to Applicant's explanation as follows:

Capek anticipates that "other functionality that may be provided by the control mechanism include the dismissal of a particular insertion or the discontinuance of insertions in general" (Capek, col. 9, lines 13-16). Hence, it is clear that Capek anticipates of a situation where the insertion manager interrupts or ceases the insertion in order to deliver the requested material to the user. In addition, according to Capek, "as evident from FIG. 4a, the client experiences a delay from time A through at least time F, and possibly through time I. During the interval from time F to time I, the user may be presented with results depending upon the specific technology and specific content for the particular instance" (Capek, col. 10, lines 47-51). Capek also states that "the client is presented with the insertion from at least time Z through time F, and perhaps from time X through time I, again depending upon the specific content and technology" (Capek, col. 10, lines 64-67). Hence, Capek anticipates that, during periods of delay in transferring the requested material to the user, the insertion manager may make determinations to deliver inserts of alternative data to the user.

Final Office action, pg. 10-11. However, Capek is concerned with reducing delays between the client and a server containing the content of an ad, i.e. delays in retrieving the ad from the server. See, Figs. 4A and 4B; col. 7: 16-25. The insertion manager does

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not insert the ad, as the final Office action appears to imply, the advertisement is inserted by the client apparently using undisclosed techniques. The insertion manager merely communicates between the client and the server, which typically stores the desired advertisement to be inserted. See, citations above. Capek clearly explains that the procedure in Fig. 4A is prior art to Capek, and Fig. 4B, in which the insertion manager provides an advertisement from its repository to the client when a certain delay has passed is the contribution to the art of Capek. See, Figs. 2, 4A and 4B; col. 10: 29-68 (“referring to FIG. 4A which does not implement the present invention” With the present invention, as illustrated in FIG. 4B”). In both Fig. 4A and 4B, the process is initiated by a request from the client, at time A, which also initiates the “dead time” time periods in the media, *i.e.* a break in the media. See, Figs. 4A and 4B. The time period for providing the advertisement to the client in Capek is clearly disclosed as being initiated by a break in the streaming media to initiate the “dead time”, *i.e.* time period A, and clearly not “independent of boundaries of the multimedia file.” In short, none of the cited portions of Capek remotely disclose or suggest the timing of an insert of an alternative media file independent to the boundaries of a multimedia file stream, as required by the above claims.

Accordingly, as explained in Applicant’s previous response, Capek simply does not disclose or suggest inserting an alternative media file into a streaming multimedia file using a first and second cache, a control unit, and a switching mechanism, wherein the alternative media file is inserted in the stream independent of boundaries of the multimedia file. To the extent that the Examiner disagrees with Applicant’s explanation, the Examiner is respectfully requested to explain the basis for any such disagreement.

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Accordingly, as Capek does not disclose or suggest each and every element of amended claims 1 and 21 and hence does not anticipate amended claims 1 and 21. Likewise, as claims 3-20 and 22-30 depend on amended claims 1 and 21 respectively, and contain all of the limitations thereof, Capek also does not anticipate claims 3-20 and 22-30.

Furthermore, the final Office action has not addressed the fact that Capek also does not disclose using a control signal output from the cache which indicates that a complete alternative file is stored and is ready for transmission to the predetermined at least one end-user, or will be ready in time to transmit, as recited by claim 2, amended to be in independent form. While the Office action cites to col. 7, lines 17-25 of Capek, Capek does not disclose the above features. Capek merely discloses to maintain an insertion repository 22 which contains all of the possible insertions from which a particular assertion is selected. Col. 7: 17-47. A repository 22 is not a cache memory, and there is no indication in Capek whether or not a particular insertion stored in the repository is ready for transmission. Capek clearly does not disclose or suggest to provide a control signal indicating that a complete alternative file is stored and is ready for transmission, or will be ready in time to transmit, as recited by claim 2. To the extent that the Examiner disagrees with Applicant, the Examiner is respectfully requested to explain the basis for such disagreement.

Finally, the final Office action asserts "the Applicants still failed to clearly disclose the novelty of the invention and identify the specific limitation, which would define patentable distinction over prior art." The Examiner is respectfully reminded that the burden of establishing a *prima facie* case lays with the Examiner, and that a *prima*

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facie case of anticipation can only be established by demonstrating that each and every element of the claims, as arranged in the claims, is disclosed in a single reference. As explained above, the Capek reference does not disclose each and every limitation of the claims and does not anticipate the claims.


III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

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Respectfully submitted,

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